

REMARKS

By this amendment, Applicant has amended claims 1, 9, 14, and 18. As a result, claims 1-20 remain pending in this application. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicant does not acquiesce in the correctness of the objections and rejections and reserve the right to pursue the full scope of the subject matter of the original claims, or claims that are potentially broader in scope, in the current and/or a related patent application. Reconsideration in view of the following remarks is respectfully requested.

I. Rejection of claims 1-8 and 14-17 under 35 U.S.C. § 101

In the Office Action, the Office rejects claims 1-8 and 14-17 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Office alleges that the claims do not recite a practical application. By this response, Applicant has amended claims 1 and 14 to expressly state that the response is stored in a recordable medium. As a result, Applicant respectfully requests withdrawal of the rejection of claims 1-8 and 14-17 as allegedly being directed to non-statutory subject matter.

II. Rejection of claims 14-17 under 35 U.S.C. § 101

Further, the Office rejects claims 14-17 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Office alleges that the claims appear to be directed to a system that is made of only software instructions. However, Applicant notes that the preamble of claim 14 recites “[a] system for tracking data.” Claim 14. In the Specification, FIG. 1 is described as showing “a system 10 for tracking data.” Specification, paragraph 0017. As clearly illustrated in FIG. 1 and described in the Specification, system 10 includes, inter alia, a server 12, which includes a tracking system 34 stored therein. To this extent, an embodiment Serial No. 10/734,038

of the claimed system for tracking data is clearly shown and described as including both a server and program code. See, e.g., Specification, paragraphs 0021, 0031. As a result, Applicant respectfully requests withdrawal of the rejection of claims 14-17 as allegedly being directed to non-statutory subject matter.

III. Rejection of claims 18-20 under 35 U.S.C. § 101

Further, the Office rejects claims 18-20 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Office alleges that since the claimed medium can comprise transmission signals, the invention fails to fall into one of the four categories of invention. Applicant traverses this holding.

The Supreme Court has stated that the text of 35 U.S.C. § 101 is intended “to include ‘anything under the sun that is made by man’ as statutory subject matter.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308-309, 206 USPQ 193, 197 (1980); MPEP 2106, IV, A. Courts have found three exceptions: abstract ideas, laws of nature and natural phenomena. MPEP 2106, IV, A. In the present case, the claimed invention clearly comprises something made by man, i.e., it would not occur naturally. Further, Applicant submits that the claimed invention does not fit into any of the three judicial exceptions, nor does the Office allege that it does.

The Office alleges that the claimed invention does not comprise a process, machine, manufacture, or composition of matter. To the contrary, Applicant respectfully submits that the claimed invention clearly comprises a manufacture. A “manufacture” is defined as, *inter alia*, any product made by manual labor or machinery. See, e.g., manufacture. Dictionary.com. *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/manufacture> (accessed: 19 June 2007).

In the current case, the claimed propagated signal clearly is made by a machine (e.g., computing Serial No. 10/734,038

device). Further, the claimed propagated signal clearly comprises a product since computer software for managing structured data is embodied therein. To this extent, computer software is routinely provided to consumers as a propagated signal over public networks, such as the Internet. As a result, Applicant submits that the claimed invention clearly comprises a manufacture.

The Office apparently relies on the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Annex IV, section C. Initially, Applicant notes that the Guidelines are not controlling law. Further, the Guidelines merely “propose that [] signal claims are ineligible for patent protection” (emphasis added), and seek “[p]ublic comment... for further evaluation of this question.” Interim Guidelines, p. 57.

Prior to publication of the Guidelines, the then-current Commissioner of Patents and Trademarks commented on the treatment of signals and stated that

[t]here is no reason to treat works that are distributed... by means of transmission differently than works distributed... by other, more conventional means. Copies distributed via transmission are as tangible as any distributed over the counter or through the mail. Through each method of distribution, the consumer receives a tangible copy of the work.

Statement of Bruce A. Lehman, Assistant Secretary of Commerce and Commissioner of Patents and Trademarks, on S. 1284 and H.R. 2441 before the Subcommittee on Courts and Intellectual Property Committee on the Judiciary, United States House of Representatives, and the Committee on the Judiciary, United States Senate, November 15, 1995.

Further, since publication of the Guidelines and issuance of the Office Action, the United States Supreme Court commented on the patentability of electronic transmissions in *Microsoft Corp. v. AT&T Corp.*, Slip Op. No. 05-1056 (April 30, 2007). The case concerned “computer software first sent from the United States to a foreign manufacturer on a master disk, or by Serial No. 10/734,038

electronic transmission...” *Microsoft*, Slip Op., p. 1. Initially, the Court addressed when software qualifies as a “component” under 35 U.S.C. § 271(f). The Court stated that software must be combinable, i.e., “expressed as a computer-readable ‘copy’”. *Microsoft*, Slip Op., p. 9. With this requirement, the Court held that “a copy of [computer software] qualifies as a ‘component’ under § 271(f).” *Microsoft*, Slip Op., p. 12. Throughout the decision, the Court used two specific examples of copies of computer software that were at issue in the case, i.e., software embodied on a master disk, e.g., CD-ROM, and software embodied in an electronic transmission. *Microsoft*, Slip Op., p. 1. To this extent, Applicant submits that the Court held that software embodied in an electronic transmission may qualify as a ‘component’ under § 271(f).

As such, Applicant submits that the Court implicitly held that software embodied in an electronic transmission comprises patentable subject matter under 35 U.S.C. § 101. In particular, at least one previous case held that the scope of 35 U.S.C. § 271(f) is commensurate with the scope of 35 U.S.C. § 101. The Federal Circuit has held that “every form of invention eligible for patenting falls within the protection of section 271(f).” *Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325, 73 U.S.P.Q.2D (BNA) 1782 (Fed. Cir. 2005). Applicant submits that the converse logically follows. That is, everything protectable under 35 U.S.C. § 271(f) is eligible for patenting under 35 U.S.C. § 101. Were this not the case, an inventor would be able to prevent another from exporting his/her invention outside of the United States under § 271(f), but would not be able to prevent another from making or using the invention in the United States.

In light of the above stated reasons, Applicant respectfully submits that claims 18-20 clearly comprise statutory subject matter under 35 U.S.C. § 101 and requests withdrawal of the rejection thereof. However, should the Office maintain this rejection, Applicant respectfully

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requests that the Office provide specific support (i.e., controlling law) for its position that the claimed invention does not comprise statutory subject matter.

IV. Rejection of claims 1-20 under 35 U.S.C. § 102

Further, the Office rejects claims 1-20 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent Application Publication No. 2002/0095401 (Redmond). In order to maintain a proper rejection under 35 U.S.C. § 102(b), the Office must show that a single reference discloses each feature of the claimed invention. Applicant submits that the Office fails to show that Redmond discloses every feature of the claimed invention.

For example, with respect to claim 1, Applicant submits that Redmond fails to disclose, *inter alia*, selecting a handler based on a tracked data item included in a request received from a client as in claim 1. In support of its rejection, the Office cites paragraph 0042 of Redmond as allegedly disclosing this feature. This portion of Redmond describes database interfaces (also referred to as SAOs), each of which corresponds to a database. Redmond, paragraphs 0039, 0042. The Office apparently correlates the SAO to the claimed handler. However, in Redmond, the SAO is typically selected using “two fields [in a request] indicating what product (and from which vendor) has sent the request. This correlates directly to an SAO.” Redmond, paragraph 0045. As a result, Redmond does not select an SAO based on a tracked data item.

Redmond also can use a translator in processing a request. Redmond, paragraph 0050. Redmond provides a request to each translator in turn, until one indicates that it can handle the request. *Id.* As a result, Redmond does not select a translator based on a tracked data item in the request. Further, Applicant has amended claim 1 to further clarify that the request is providing update data for the tracked data item and/or requesting data for the tracked data item.

As a result, Applicant respectfully requests withdrawal of the rejections of claim 1 and claims 2-8, which depend therefrom as allegedly being anticipated by Redmond. However, should the Office maintain the rejection, Applicant respectfully requests that the Office clarify what corresponds to the claimed “tracked data item” in Redmond. The remaining independent claims 9, 14, and 18 include similar limitations as that discussed above with respect to claim 1. As a result, Applicant also respectfully requests withdrawal of claims 9-20 as allegedly being anticipated by Redmond in view of the remarks presented above with respect to claim 1.

With further respect to claims 3, 9 and 18, Redmond fails to disclose selecting the handler based on the tracked data item and the client as in claims 3, 9 and 18. In support of its rejection, the Office cites paragraph 0044 of Redmond (rejection of claim 3). This paragraph describes an override for the normal SAO selection. In particular, an administrator can specify that “All requests that come from the player X should be dealt with by Y SAO.” Redmond, paragraph 0044. However, as an override, the player-based selection is exclusive of other selection criteria, such as is normally used in selecting the SAO. In sharp contrast, the handler is selected based on both the tracked data item and the client in claims 3, 9 and 18.

As a result, Applicant again respectfully requests withdrawal of the rejections of claims 3, 9 and 18 as allegedly being anticipated by Redmond. However, should the Office maintain the rejection, Applicant respectfully requests that the Office clarify how Redmond discloses selecting an SAO based on both a tracked data item and a client.

V. Conclusion

Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office’s interpretation of the claimed subject matter or the references used in rejecting the claimed Serial No. 10/734,038

subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary and/or in a related patent application, either of which may seek to obtain protection for claims of a potentially broader scope.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

/John LaBatt/

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